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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,783	01/24/2000	Richard C. Johnson	ORCL5628	7640

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YOUNG LAW FIRM
A PROFESSIONAL CORPORATION
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EXAMINER

KAPADIA, MILAN S

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 07/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/490,783

Applicant(s)

JOHNSON, RICHARD C.

Examiner

Milan S Kapadia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,3,4</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 24 January 1999. Claims 1-28 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy et al (6,236,972) in view of Wollinsky (Wollinsky, Howard, "Parts Trader Gets on Fast Track," Chicago Sun Times, November 3, 1997.).

(A) As per claim 1, Shkedy teaches a method of enabling shipment of a package containing goods purchased by a customer from a vendor for delivery to an address, comprising the steps of:

receiving a request for a package code for the package from the vendor (Shkedy; col. 4, lines 46-49; the examiner interprets the "seller" as the "vendor" and interprets the "sell order" as the "request for a package code");

sending a shipping identifier and an associated address to the shipper (Shkedy; col. 4, lines 54-58; the examiner interprets the "buy order" as including the "shipping identifier," the "buy tracking identification" as including the "associated address," and the "intermediate" as the "shipper". It is respectfully submitted that in the case of the physical delivery of the stock certificates, the "buy tracking identification" would include an "associated address"), whereby the shipper, after picking up the package for shipment from the vendor, matches the package code sent to the vendor with the shipping identifier and identifies the associated address as the delivery address of the package (Shkedy; col. 4, lines 59-65 and col. 6, line 59-col. 7, line 3).

Shkedy fails to expressly teach sending the package code to the vendor, the package code being devoid of delivery address information, though Shkedy does teach the transaction is executed anonymously (Shkedy; col. 20, line 64-col. 21, line 10). However, this feature is old and well known in the art, as evidenced by Wolinsky's teachings with regards to sending the package code to the vendor, the package code being devoid of delivery address information (Wolinsky; page 2, paragraph 8; the examiner interprets the "seller" as the "vendor" and it is respectfully submitted, that the package code has been sent to the vendor devoid of the delivery address, in order to enable the vendor to ship the "components to FastParts.") It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the

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invention was made, to expand the system taught by Shkedy with Wollinsky's teaching with regards to sending the package code to the vendor, the package code being devoid of delivery address information, with the motivation of creating a new channel for purchasing and dispensing of excess inventory (Wollinsky; page 2, paragraph 16).

(B) As per claim 3, Shkedy discloses the received request includes at least one of a request for authentication and an electronic draft for payment of at least one of the purchased goods and a shipping charge (Shkedy; col. 6, lines 45-55, col. 17, lines 1-15, and col. 21, lines 50-60)

(C) As per claims 4 and 5, Shkedy discloses wherein the receiving and sending steps are performed over a computer network, wherein the computer network includes at least one of leased lines, a private network, a virtual private network, and the Internet (Shkedy; col. 8, lines 50-58).

(D) As per claim 6, Shkedy teaches wherein the receiving and sending are carried out by a bank (Shkedy; col. 16, lines 14-44).

4. Claims 2, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, and 28e rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy et al (6,236,972) and Wollinsky (Wollinsky, Howard, "Parts Trader Gets on Fast Track," Chicago Sun Times, November 3, 1997.) as applied to claims 1, 3, 4, 5, and 6 above and further in view of Wilz, Sr et al. (6,394,354).

(A) per claim 2, Shkedy fails to expressly teach wherein the package code includes at least one of a code number and machine-readable indicia expressing the code number. However, this feature is old and well known in the art, as evidenced by Wilz's teachings with regards to the package code includes at least one of a code number and machine-readable indicia expressing the code number (Wilz; col. 26, lines 25-31). It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Shkedy with Wilz's teaching with regards to the package code includes at least one of a code number and machine-readable indicia expressing the code number, with the motivation of routing and tracking the delivery of the package (Wilz; col. 26, 29-31).

(B) per claim 7, Shkedy teaches a method of processing a package identified by a package code, the package containing goods purchased by a customer from a vendor for shipment to an address comprising the steps of:

receiving a request to pick up a package from the vendor, the package having a package code affixed thereto, the request including a shipping identifier and a delivery address associated with the shipping identifier (Shkedy; col. 4, lines 54-58; the examiner interprets the "buy order" as the "request to pick up a package from the vendor," the "buy tracking identification" as including "delivery address," and the "sell tracking identification" as including the "package code." It is respectfully submitted that

in the case of the physical delivery of the stock certificates, the “buy tracking identification” would include a “delivery address”);

picking up the package from the vendor (Shkedy; col. 14, lines 26-51; the examiner interprets “checks with the transfer agent” as “picking up the package from the vendor”)

reading the package code affixed to the package (Shkedy; col. 14, lines 26-51);
matching the package code with the received shipping identifier, and
delivering the package to the delivery address associated with the shipping identifier (Shkedy; col. 14, line 52-col. 15, line 29).

Shkedy fails to expressly teach the package code is devoid of address information. However, this feature repeats features of claim 1 and is therefore rejected for the same reasons give above in the rejection of claim 1 and incorporated herein.

Shkedy and Wollinsky collectively fail to expressly teach wherein the package having a machine-readable package affixed thereto. However, this feature repeats the limitation of claim 2 and is therefore rejected for the same reasons give above in the rejection of claim 2 and incorporated herein.

(C) per claim 8 Shkedy fails to expressly teach printing a shipping label on which the delivery address is visible and affixing the shipping label on the package. However, this feature is old and well known in the art, as evidenced by Wilz’s teachings with regards printing a shipping label on which the delivery address is visible and affixing the shipping label on the package (Wilz; col. 26, lines 25-31). It is respectfully submitted,

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that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Shkedy with Wilz's teaching with regards to printing a shipping label on which the delivery address is visible and affixing the shipping label on the package, with the motivation of routing and tracking the delivery of the package (Wilz; col. 26, 29-31).

(D) aims 9-12 repeat the limitations of claims 2 and 4-6 and are therefore rejected for the same reasons given above in the rejection of claims 2 and 4-6 and incorporated herein.

(E) As per claim 13, Shkedy teaches a method of causing a package of goods purchased from a vendor to be delivered to an address comprising the steps of:

 sending a request for a package code to a trusted entity (Shkedy; col. 4, lines 46-49; the examiner interprets the "intermediate" as the "trusted entity" and interprets the "sell order" as the "request for a package code";

 receiving the package code (Shkedy; col. 4, lines 46-54; the examiner interprets the "sell tracking identification" as including the "package code" ;

 affixing the package code to the package (Shkedy; col. 14, lines 26-51), and

 surrendering the package to a shipper, whereby the shipper matches the package code with a shipping identifier and associated delivery address previously received from the trusted entity (Shkedy; col. 4, lines 59-60; the examiner interprets the "intermediate" as the "shipper," the "buy order" as "shipping identifier," and the buy

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tracking identification" as including the "associated delivery address." It is respectfully submitted that in the case of the physical delivery of the stock certificates, the "buy tracking identification" would include a "delivery address).

Shkedy fails to expressly teach the package code is devoid of address information. However, this feature repeats features of claim 1 and is therefore rejected for the same reasons give above in the rejection of claim 1 and incorporated herein.

Shkedy and Wollinsky collectively fail to expressly teach generates a shipping label specifying the associated delivery address and affixes the label to the package. However, this feature repeats the limitation of claim 8 and is therefore rejected for the same reasons give above in the rejection of claim 8 and incorporated herein.

(F) Claims 14-17 repeat the limitations of claims 2, 3, 4, and 6 and are therefore rejected for the same reasons given above in the rejection of claims 2, 3, 4, and 6 and incorporated herein.

(G) As per claim 18, Shkedy teaches a method enabling a customer to anonymously purchase an item from a vendor via an electronic draft for delivery to an address comprising the steps of:

storing, in a bank, an encrypted unique identifier for the customer, the encrypted unique identifier being linked to the customer's personal and financial information stored in the bank, including the delivery address (Shkedy; col. 9, lines 48-52, col. 13, lines 17-20, and col. 17, lines 3-23);

authenticating the customer having caused a draft to be executed for payment of at least one of a purchase price of the item and a shipping cost by encrypting at least a portion of an identification data provided by the customer and successfully matching the encrypted identification data with the stored encrypted unique identifier (Shkedy; col. 4, line 66-col. 5, line 7);

retrieving at least the authenticated customer's financial information and delivery address (Shkedy; col. 6, lines 46-58; It is respectfully submitted that in the case of the physical delivery of the stock certificates, the delivery address could also be authenticated);

honoring a draft presented by the vendor for payment of the item only when the customer is successfully authenticated by the bank (Shkedy; col. 7, lines 1-3);

assigning a package code to the item, the assigned package code being associated with the retrieved delivery address (Shkedy; col. 4, lines 50-58);

sending the package code and the associated delivery address to a shipper for storage in a shipper database, whereby the shipper picks up the item from the vendor (Shkedy; col. 4, lines 46-58; the examiner interprets the "intermediate" as the "shipper").

Shkedy fails to expressly teach sending only the package code to the vendor, the package code being devoid of delivery address information, though Shkedy does teach the transaction is executed anonymously (Shkedy; col. 20, line 64-col. 21, line 10). However, this feature is old and well known in the art, as evidenced by Wolinsky's teachings with regards to sending the package code to the vendor, the package code being devoid of delivery address information (Wolinsky; page 2, paragraph 8; the

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examiner interprets the “seller” as the “vendor” and it is respectfully submitted, that the package code has been sent to the vendor devoid of the delivery address, in order to enable the vendor to ship the “components to FastParts.”) It is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to expand the system taught by Shkedy with Wollinsky’s teaching with regards to sending the package code to the vendor, the package code being devoid of delivery address information, with the motivation of creating a new channel for purchasing and dispensing of excess inventory (Wollinsky; page 2, paragraph 16).

Shkedy and Wollinsky collectively fail to teach prints out a shipping label for the package, a delivery address on the label being that customer address linked to a package code stored in the shipper database that matches the package code affixed to the package. However, this feature repeats the limitation of claim 8 and is therefore rejected for the same reasons give above in the rejection of claim 8 and incorporated herein.

(H) As per claim 19, Shkedy teaches the identification data includes at least one of an ID and a password, the password being known to the bank only in encrypted form, biometric data and a digital certificate (Shkedy; col. 4, line 66-col. 5, line 7).

(I) As per claim 20, Shkedy teaches the customers’ encrypted unique identifier, personal and

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financial information are stored in a data structure managed by a Directory software controlled by the bank (Shkedy; col. 9, lines 33-47).

(J) As per claim 21, Shkedy, Wollinsky, and Wilz collectively fail to expressly teach wherein the package code and the linked customer address are replicated in the shipper address via Light Weight Directory Access Protocol (LDAP)). However, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Shkedy, Wollinsky, and Wilz with regards to this limitation, with the motivation of preventing the loss of data by providing a backup up copy with a commonly known method of accessing data.

(K) As per claim 22, Shkedy, Wollinsky, and Wilz collectively fail to expressly teach at least portion of the shipper database is replicated in a portable electronic device equipped with a package scanner and a shipping label printer. However, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Shkedy, Wollinsky, and Wilz with regards to this limitation, with the motivation of enabling the matching between the buy and sell orders to be done remotely.

(L) Claims 23-25 repeat the limitations of claims 2, 4, and 5 and are therefore

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rejected for the same reasons given above in the rejection of claims 2, 4, and 5 and incorporated herein.

(M) As per claim 26, Shkedy, Wollinsky, and Wilz collectively fail to expressly teach wherein the customer is a business. However, it is respectfully submitted, that it would have been obvious, to one having ordinary skill in the art at the time the invention was made, to modify the collective system taught by Shkedy, Wollinsky, and Wilz with regards to this limitation, with the motivation of enabling the system to work with the diverse set of customers in the market for purchasing products and services.

(N) Claim 27 differs from claim 1 by reciting the associated delivery address as an electronic address, the product comes in a digital form, and the vendor forwarding the goods to a different electronic address. As per these limitations, Shkedy teaches an embodiment of his system can be used with electronic email addresses and used to exchange digital files, graphics, video, and audio (Shkedy; col. 10, line 54-col. 11, line 7).

(O) Claim 28 repeats the features of claim 6 and is therefore rejected for the same reasons given above in the rejection of claim 6 and incorporated herein.

Conclusion


5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches a real-time network exchange with seller specified exchange parameters and interactive seller participation (6,058,379); an exchange method and apparatus (2002/0023037); an electronic transaction method and apparatus (2001/0029492); a method, apparatus, system, and firmware for secure transactions (5,748,740); electronic commerce using a secure courier system (5,671,279); an electronic procurement system and method for trading partners (5,970,475); a method and apparatus for facilitating buyer-driven purchase orders on a commercial network system (6,260,024); and a computer method and system for intermediated exchange of commodities (5,873,071).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milan S Kapadia whose telephone number is 703-305-3887. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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mk
June 27, 2002


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600